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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,583	08/22/2003	Nitin J. Shah		9950
7590	04/19/2005		EXAMINER	
Robert C. Lyne, Jr. Thompson & McMullan 100 Shockoe Slip Richmond, VA 23219			BOCHNA, DAVID	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/646,583	SHAH, NITIN J.	
	Examiner David E. Bochna	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 January 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
  - 4a) Of the above claim(s) 5-10, 14-18 is/are withdrawn from consideration.
- 5) Claim(s) 3, 4 and 11-13 is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION*****Election/Restrictions***

1. Newly amended claims 5-10 and 14-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Invention I, claims 5-10 and 14-18 and invention II, claims 1-4 and 11-13 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process, such as brazing or soldering the fitting the pipe together or welding the fitting the pipe together without applying an annulus of added bead metal. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-10 and 14-18 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Kane.

In regard to claim 1, Brown discloses a hollow metal fitting 10 for use in making a welded metal joint with reduced residual stresses, which fitting comprises an internal annular shoulder 13 having an inner diameter; and an annular wall which

(1) extends from the shoulder,

(2) has a cylindrical inner surface,

(3) has a cylindrical outer surface whose diameter is greater than the inner diameter of the shoulder,

(4) defines with the shoulder a cylindrical socket having a common longitudinal axis with the annular wall, and

(5) has an end surface 14 connecting the cylindrical outer and inner surfaces, which end surface is chamfered so that the inner surface extends beyond the outer surface in the axial direction and so that the end surface, as viewed in a cross section taken along the longitudinal axis of the annular wall, however, Brown discloses making the end surface chamfered in order to provide a pipe joint with adequate structural strength, but Brown does not disclose that the end surface is concave. Kane discloses providing a concave surface 28 in order to form a weld pocket that will receive enough weld material to improve the strength of the welded joint. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the end surface of Brown, to include a concave surface, as taught by Kane, in order to improve the welding surface of the pipe joint, thereby creating a better weld joint between the connected pipes.

In regard to claim 2, wherein the chamfered end surface terminates in an annular lip (end surface of 14) at the cylindrical inner surface of the annular wall.

*Allowable Subject Matter*

2. Claims 3-4 and 11-13 are allowed.

*Response to Arguments*

3. Applicant's arguments filed 1/28/05 have been fully considered but they are not persuasive. Applicant argues that it would not have been obvious to combine the concave end surface of Kane to the end surface of Brown because the chamfer 14 and shoulder 7 of Brown already create a dam. However, making the weld dam with concave surfaces, as taught by Kane, allows the dam area to have a greater volume and surface area, which allows it to hold more weld material, thereby making for a stronger weld joint. Making a strong connection with a weld joint was the purpose of the Brown invention.

Applicant also argues that chamfer is such that the inner surface of the fitting's annular wall extends away from the shoulder and beyond the annular wall's outer surface in the axial direction, and thus cannot be interpreted to read on a reverse chamfer or undercut as disclosed by Kane. However, Brown discloses the end surface extending away from the shoulder and past the annular wall's outer surface. Kane is not used to teach this limitation. Kane is only used to teach that it would have been obvious to make a chamfered end surface concave.

Applicant also argues that the pipe of Kane must have a groove in order to enable the weld material to resist shear forces. However, claims 1 and 2 do not require that the exterior of the pipe be free of grooves.

With respect to Applicant's fourth argument, claims 1 and 2 were not rejected on Brown alone.

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4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



David Bochna  
Primary Examiner  
Art Unit 3679  
April 15, 2005